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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,852	07/22/2003	Eric Lawrence Barsness	ROC920030065US1	6557
30206	7590	11/01/2007	EXAMINER	
IBM CORPORATION			MILIA, MARK R	
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3605 HIGHWAY 52 NORTH			PAPER NUMBER	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/624,852

Applicant(s)

BARSNESS ET AL.

Examiner

Mark R. Milia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,5-10,14-17,23 and 24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,5-10,14-17,23 and 24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 August 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendment was received on 8/16/07 and has been entered and made of record. Currently, claims 1, 5-10, 14-17, and 23-24 are pending.

### ***Drawings***

2. The drawings were received on 8/16/07. These drawings are accepted. Applicant's amendment to Fig. 3 has overcome the objection set forth in the previous Office Action. Therefore the objection has been withdrawn.

### ***Specification***

3. Applicant's amendment to Fig. 2 and the removal of embedded hyperlinks from the specification has overcome the objection set forth in the previous Office Action. Therefore the objection has been withdrawn.

***Claim Rejections - 35 USC § 101***

4. Applicant's amendment to claim 17 and the cancellation of claims 18-22 has overcome the rejection set forth in the previous Office Action. Therefore the rejection has been withdrawn.

***Response to Arguments***

5. Applicant's arguments with respect to claims 1, 10, and 17 have been considered but are moot in view of the current amendment to the claims and therefore a new ground(s) of rejection will be made.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5-10, 14-17, and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over McIntyre (US 6,958,821) in view of U.S. Patent No. 6,965,682 to Davis et al.

Regarding claim 1, McIntyre discloses an apparatus, comprising: at least one processor (see Figs. 2A and 2B and column 5 lines 12-31), a memory coupled to the at least one processor (see Fig. 4, column 4 lines 1-12, column 5 lines 39-66, and column 8 lines 1-48, reference states that kiosk **170** is an example of an image capable computer **100**, therefore kiosk **170** would also contain the same elements of computer **100**, such as memory, which is also eluded to frequently throughout the reference), at least one digital image residing in the memory (see Fig. 4, column 4 lines 1-12, and column 8 lines 1-48), and an advertising generator residing in the memory and executed by the at least one processor, the advertising generator analyzing a selected digital image for one or more consumer identifying characteristics, and generating an advertisement targeted to a consumer based on the one or more consumer identifying characteristics (see column 2 lines 22-40, column 8 lines 26-48, 56-59, and 63-65, and column 11 line 57-column 12 line 7), wherein the analyzing of the selected digital image involves object recognition within the selected digital image (see column 2 lines 30-36, column 5 lines 39-52, column 8 lines 5-10, and column 9 line 53-column 10 line 6), text recognition within the selected digital image (see column 2 lines 30-36, column 5 lines 39-52, column 8 lines 5-10, and column 9 line 53-column 10 line 6), and storing metadata associated with the digital image (see column 18 line 57-column 19 line 6).

McIntyre does not disclose expressly reading consumer characteristic metadata associated with the digital image.

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Davis discloses reading consumer characteristic metadata associated with the digital image (see column 2 lines 20-25 and 33-40, column 2 line 62-column 3 line 14, and column 3 lines 28-37).

Regarding claim 10, McIntyre discloses a method for advertising to a consumer based on the content of a digital image associated with the consumer, the method comprising the steps of: analyzing the digital image for one or more consumer identifying characteristics (see column 2 lines 22-40, column 8 lines 26-48, 56-59, and 63-65, and column 11 line 57-column 12 line 7), the analysis comprising the steps of: performing objection recognition within the digital image (see column 2 lines 30-36, column 5 lines 39-52, column 8 lines 5-10, and column 9 line 53-column 10 line 6), performing text recognition within the digital image (see column 2 lines 30-36, column 5 lines 39-52, column 8 lines 5-10, and column 9 line 53-column 10 line 6), and storing metadata associated with the digital image (see column 18 line 57-column 19 line 6), and generating an advertisement targeted to the consumer based on the one or more consumer identifying characteristics (see column 2 lines 22-40, column 8 lines 26-48, 56-59, and 63-65, and column 11 line 57-column 12 line 7).

McIntyre does not disclose expressly reading consumer characteristic metadata associated with the digital image.

Davis discloses reading consumer characteristic metadata associated with the digital image (see column 2 lines 20-25 and 33-40, column 2 line 62-column 3 line 14, and column 3 lines 28-37).

Regarding claim 17, McIntyre discloses a program product comprising: an advertising generator that analyzes a selected digital image for one or more consumer identifying characteristics, the analysis comprising the steps of: performing objection recognition within the digital image (see column 2 lines 30-36, column 5 lines 39-52, column 8 lines 5-10, and column 9 line 53-column 10 line 6), performing text recognition within the digital image (see column 2 lines 30-36, column 5 lines 39-52, column 8 lines 5-10, and column 9 line 53-column 10 line 6), and storing metadata associated with the digital image (see column 18 line 57-column 19 line 6), and generates an advertisement targeted to a consumer based on the one or more consumer identifying characteristics and computer-readable signal bearing media bearing the advertising generator (see column 2 lines 22-40, column 8 lines 26-48, 56-59, and 63-65, and column 11 line 57-column 12 line 7).

McIntyre does not disclose expressly reading consumer characteristic metadata associated with the digital image.

Davis discloses reading consumer characteristic metadata associated with the digital image (see column 2 lines 20-25 and 33-40, column 2 line 62-column 3 line 14, and column 3 lines 28-37).

McIntyre & Davis are combinable because they are from the same field of endeavor, performing processes based on the analysis of image data.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the reading of hidden watermarks (metadata) that cause a certain process to be performed, as described by Davis, with the system of McIntyre

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because McIntyre discloses a system to generate advertising based on analyzed image data and McIntyre further acknowledges the need to store metadata associated with the image data, such metadata being image identifier/locator which act as a reference to the digital image file and an image name/id and Davis discloses an example in which embedded watermarks are used in advertising and the reading of such a watermark would prompt the execution of an output process, such as playing a video or printing an image. Watermarking is well known and commonly used in the art. Therefore, it would have been obvious to a person of ordinary skill in the art to combine the teachings of McIntyre and Davis to arrive at the instant invention.

Therefore, it would have been obvious to combine Davis with McIntyre to obtain the invention as specified in claims 1, 10, and 17.

Regarding claim 5, McIntyre further discloses wherein the apparatus is a photo kiosk (see Fig 2A **170**).

Regarding claim 6, McIntyre further discloses wherein the apparatus is a digital minilab (see column 9 lines 14-30).

Regarding claims 7 and 15, McIntyre further discloses wherein the generated advertisement is a screen display (see Fig. 1).

Regarding claims 8 and 16, McIntyre further discloses wherein the generated advertisement is a coupon (see column 8 lines 63-65).

Regarding claim 9, McIntyre further discloses wherein the generated advertisement is a photo jacket insert (see column 8 lines 40-48).



Regarding claim 14, McIntyre further discloses creating a mapping from one or more potential consumer identifying characteristics to at least one associated advertisement, if at least one consumer identifying characteristic exists within the digital image, identifying at least one associated advertisement to display to the consumer via the mapping (see column 9 line 53-column 11 line 22, column 13 lines 1-48, column 14 lines 18-38, and column 19 line 24-column 21 line 8) and presenting the at least one associated advertisement to the consumer (see Fig. 1 and column 8 lines 56-59 and 63-65).

Regarding claim 18, McIntyre further discloses wherein the computer-readable signal bearing media comprises recordable media (see Fig. 4).

Regarding claims 23 and 24, Davis further discloses wherein the consumer characteristic metadata is provided in the form of a digital watermark (see column 2 lines 20-25 and 33-40, column 2 line 62-column 3 line 14, and column 3 lines 28-37).

***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

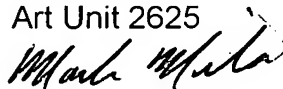
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark R. Milia whose telephone number is (571) 272-7408. The examiner can normally be reached M-F 8:00am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler M. Lamb can be reached at (571) 272-7406. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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